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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFAN HOLZ, JANE LIU, and DAVE WINIKOFF

Appeal 2009-009073
Application 10/649,778
Technology Center 2600

Before ALLEN R. MacDONALD, ELENi MANTIS MERCADER,
and CARL W. WHITEHEAD, JR., *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

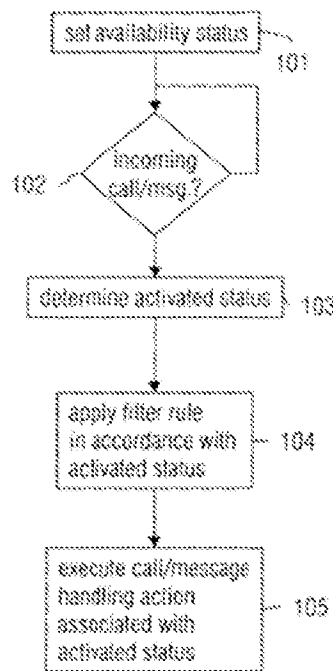
Appellants appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1 and 3-10. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

Appellants' Figure 1 is reproduced below:

FIG 1



Appellants' Figure 1 and claimed invention are directed to method of managing incoming calls and/or messages in a communications system (Spec. ¶ [0018]). First, a user or recipient respectively selects an availability status from a list associated with a user profile (step 101) (*id.*). Preferably, an availability status should be chosen that reflects the current readiness of a user of accepting a call or a message, as characterized by, e.g., 'in office,' 'in conference,' 'on holiday,' etc. In a next step, incoming calls and

messages directed to the user are monitored (step 102) (*id.*). If a call or message has been received, the activated availability status will be determined by querying a database allocated to the call/message management controller described below (step 103) (*id.*).

After having determined the activated availability status, a filter rule is applied to the incoming call or message in accordance with the activated availability status (step 104) (Spec. ¶ [0019]). A call/message handling action associated with the activated availability status is executed (step 105) (Spec. ¶ [0020]). For example, a call or message is forwarded to another pre-defined recipient (*id.*).

Claim 1, reproduced below, is representative of the subject matter on appeal (emphasis added):

1. A method of managing incoming calls and/or messages in a communications system comprising the steps of:
 - upon receipt of a call and/or message checking if a pre-defined availability status allocated to a predetermined recipient of the call and/or message is activated;
 - upon activation of a pre-defined availability status applying a pre-defined filter rule to the call and/or message in accordance with the activated availability status; and
 - executing a call and/or message handling action associated with the activated availability status;

wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Tiliks	US 2003/0076941 A1	Apr. 24, 2003
Khakoo	US 2003/0135569 A1	Jul. 17, 2003

The following rejections are before us for review:

1. The Examiner rejected claims 1, 3, 4, 6, 7, 9, and 10 under 35 U.S.C. § 102(e) as anticipated by Khakoo.
2. The Examiner rejected claims 5 and 8 under 35 U.S.C. § 103(a) as unpatentable over Khakoo in view of Tiliks.

ISSUES

1. Did the Examiner err in determining that Khakoo teaches the limitation of “wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message” as recited in claim 1 and similarly recited in claims 9 and 10?
2. Did the Examiner articulate reasoning with some rational underpinning to support the legal conclusion of obviousness in combining Khakoo in view of Tiliks under 35 U.S.C. § 103(a) in the rejection of claims 5 and 8?

FINDINGS OF FACT

The following Findings of Fact are supported by a preponderance of the evidence:

1. Khakoo teaches:

[t]he instant message delivery server 100 updates the presence and device address entries based on the automatic detection of the presence of the user or by a process of manual registration by the user, in any known manner. Thus, the instant message delivery server 100 is always able to determine whether a user is available.

(¶ [0021]).

2. Khakoo teaches: “As shown in FIG. 1, the instant message delivery server 100 maintains a presence database 200, discussed below in conjunction with FIG. 2, to record information for each user in the community, including the availability of each user to receive instant messages.” (¶ [0018]).

3. Khakoo teaches that Figure 2 is a sample table from the exemplary presence database 200 of Figure 1. Figure 2 indicates user A’s “availability” status (presence status 240) such as “ONLINE . . . AWAY.” (See ¶ [0020]; Fig. 2).

4. Khakoo teaches that after an instant message is received, the instant message delivery server 100 performs a test during step 310 to determine if the recipient is available. If during step 310 the user is determined as available, then the instant message delivery process 300 delivers the message according to steps 310, 315 to 350 as shown in Figure 3 and according to the information in the presence database 200 (Fig. 2). If the step 310 test determines that the user is unavailable, then the instant message delivery process 300 delivers the message according to steps 310, 360 to 370 as shown in Figure 3 and according to the information in the presence database 200 (Fig. 2). (See Figs. 2-3; ¶¶ [0022] –[0024]).

PRINCIPLES OF LAW

The Supreme Court stated that “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Discussing the question of obviousness of a patent that claims a combination of known elements, *KSR* explains:

If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [v. *AG Pro, Inc.*, 425 U.S. 273 (1976),] and *Anderson's-Black Rock[, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969),] are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Id. at 417.

ANALYSIS

1. Does Khakoo teach the limitation of “wherein the availability status is selectable for activation by the predetermined recipient of the call and/or message” as recited in claim 1 and similarly recited in claims 9 and 10?

Appellants argue (App. Br. 6-12) that Khakoo does not disclose an availability status that is “selectable for activation by the predetermined recipient of the call and/or message” as recited in independent claim 1. Appellants contend (App. Br. 6) *inter alia* that in contrast, Khakoo’s messages are delivered to one or more intended recipients based on their presence, preferences, or location. Appellants further argue (App. Br. 6-7) that in Khakoo the user has no control over the information maintained in the database and Khakoo’s message delivery server performs a test to determine if the recipient is available. Appellants argue (App. Br. 10; Reply Br. 4) that in Khakoo, manual registration by the user updates the presence and device address *entries*, not the user’s presence *status*.

We do not agree with Appellants' arguments. We agree with the Examiner's findings and reasoning (Ans. 3-4, 8) that in Khakoo a user can manually register his/her presence or availability status at least as "online" (available status) or "away" (unavailable status) in the presence database (FF 3). When the user's status is determined as being "away" by the instant message delivery server 100, an unavailable status (of the user) is activated whereby messages are delivered based on this status (FF 1, 2, 4). When the user's status is determined as being "online" (present), an available status is activated whereby messages are delivered based on this status (FF 1, 2, 4). Therefore, Khakoo teaches that an availability status (available or unavailable) *is selectable* by a user for activation which status is identified by the instant message delivery server 100.

Appellants argue (App. Br. 10; Reply Br. 3-4) that Khakoo's "presence" is different from the claimed "availability status" because "a user can be present at a device, but unavailable to receive a call or a message." Appellants contend (App. Br. 10) that in Khakoo, "if the user is determined to be present, then the user is available." However, Appellants' argument is not commensurate with the scope of the claim. We agree with the Examiner (Ans. 5; FF 3) that Khakoo's presence statuses, either present (available status) or away (unavailable status), reads on claim 1's "availability status" because if the user is away, the user is unavailable, and if the user is present, then the user is available.

Thus, we will sustain the Examiner's rejection of independent claim 1 and claims 9 and 10 that recite similar limitations. We will also sustain the rejection of claims 3, 4, 6, and 7, which fall with claim 1 as no additional

arguments of patentability were presented with respect to these claims. *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987).

2. Did the Examiner articulate reasoning with some rational underpinning to support the legal conclusion of obviousness in combining Khakoo in view of Tiliks under 35 U.S.C. § 103(a) in the rejection of claims 5 and 8?

Appellants argue (App. Br. 26) that the combination is improper because the Examiner has pointed to no evidence, either in the references or the general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. Appellants argue (*id.*) that the Examiner used hindsight to make the combination.

We are not persuaded by Appellants' arguments. We agree with the Examiner's rationale (Ans. 7) that it would have been obvious to modify Khakoo by routing the messages to a destination associated with an entry in a personal scheduler as taught by Tiliks for the predictable result that the message recipient could easily change their schedule and rules for receiving messages and/or calls (*id.*). *See KSR*, 550 U.S. at 417. We find that the Examiner's reasoning has sufficient rational underpinning to support the legal conclusion of obviousness. *See id.* at 418.

CONCLUSIONS

1. The Examiner did not err in determining that Khakoo teaches the limitation of "wherein the availability status is selectable for activation by

the predetermined recipient of the call and/or message” as recited in claim 1 and similarly recited in claims 9 and 10.¹

2. The Examiner articulated reasoning with some rational underpinning to support the legal conclusion of obviousness in combining Khakoo in view of Tiliks under 35 U.S.C. § 103(a) in the rejection of claims 5 and 8.

ORDER

The decision of the Examiner to reject claims 1 and 3-10 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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¹ We have decided the appeal before us. However, should there be further prosecution of these claims, the Examiner’s attention is directed to recently issued guidance from the Director as follows below in the citations to the Federal Register and Official Gazette.

Should there be further prosecution with respect to claims 9 and 10, the Examiner’s attention is directed to *Aristocrat Techs. Austl. Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328 (Fed. Cir. 2008), and 76 Fed. Reg. 7162, 7167-68 at Part 1(III)(C)(1-3).

Should there be further prosecution with respect to claim 10, the Examiner’s attention is directed to *In re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007), and *Subject Matter Eligibility of Computer Readable Media*, 1351 OFFICIAL GAZ. U.S. PAT. & TRADEMARK OFF. 212 (Feb. 23, 2010).